

REMARKS

Claims 1-37 remain pending and under current examination. Applicant respectfully requests reconsideration of this application in light of the following remarks.

I. Regarding the Final Office Action

In the Office Action¹, the Examiner rejected claims 1-37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,009,551 to Lynch et al. ("*Lynch*").

Applicant respectfully traverses the Examiner's rejection for the following reasons.

II. Regarding the rejection of claims 1-37 under 35 U.S.C. § 103(a) as being unpatentable over *Lynch*

Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1-37 because a *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

A *prima facie* case of obviousness has not been established because, among other things, *Lynch* does not teach or suggest each and every element of Applicant's claims.

Claim 1 recites a combination including, for example, a system

to determine a first status of a first floating point operand based upon data within the first floating point operand; and

... to assert a resulting floating point operand containing ... a resulting status embedded within the resulting floating point operand

(emphasis added). *Lynch* does not teach or suggest at least these elements.

The Examiner agrees that *Lynch* fails to teach or suggest each and every element, stating "Lynch et al. does not explicitly disclose the resulting status embedded with the resulting floating operand" (Office Action at p. 2). The Examiner has not provided any reference teaching or suggesting at least this element, as required by M.P.E.P. § 2142 discussed above, and requested in the previous Response of February 2, 2005 at pages 12 and 13. M.P.E.P. § 2144.03(c) states "[i]f applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained."

Because the Examiner has not provided any reference teaching or suggesting at least this element, no *prima facie* case of obviousness has been established with respect to claim 1. Accordingly, Applicant respectfully requests that the Examiner withdraw the finality of the Office Action mailed May 25, 2005. Moreover, at least because the Examiner agrees that *Lynch* fails to teach or suggest each and every element of claim 1, Applicant respectfully requests the Examiner to reconsider and

withdraw the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over *Lynch*.

Nevertheless, in response to reasoning presented in Applicant's previous Response of February 2, 2005, the Examiner asserts,

although *Lynch et al.* does not explicitly disclose a "resulting status embedded within the resulting floating operand", the teachings of an associated tag field for each operand in the register stack that stores operand results, and a tag generation for each result would make it obvious to a person of ordinary skill in the art to store both the result with its associated tag generated by steps 144 in a register field (78) and its associated tag field (89) of the register stack (84), respectively, in order to quickly determine its status in subsequent operations.

(Office Action at p. 3). Applicant respectfully submits that this is incorrect.

Lynch teaches "FPU core 94 uses the tag value associated with an operand to determine whether the operand is a special floating point number" (emphasis added, *Lynch*, col. 16, lines 62-65). *Lynch* teaches "[a] tag value is appended" (col. 5, line 44). As conceded by the Examiner, such teachings by *Lynch* do not constitute teachings or suggestions of at least a "resulting status embedded within the resulting floating point operand," (emphasis added) as recited by claim 1. Therefore, *Lynch* fails to teach or suggest each and every element of claim 1.

The M.P.E.P. further instructs that,

[a]fter indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification

(emphasis added, M.P.E.P. § 706.02(j)).

The Examiner asserts “it would have been obvious to ... store both the result with its associated tag generated by steps 144 in a register field (78) and its associated tag field (89) of the register stack (84), respectively, in order to quickly determine its status in subsequence operations” (Office Action at p. 3). Not only is this incorrect, but it does not constitute the required “explanation of why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.” Id.

Lynch is directed to “apparatus and method for tagging floating point operands and results for rapid detection of special floating point numbers” (*Lynch*, title). *Lynch* is directed to “rapid” or “quick” detection of a status, yet, as conceded by the Examiner, *Lynch* does not teach or suggest the very element alleged to be obvious. *Lynch* does not teach or suggest at least “resulting status embedded within the resulting floating point operand,” (emphasis added) as recited by claim 1.

Because *Lynch* does not teach or suggest each and every element recited by claim 1, no *prima facie* case of obviousness has been established with respect to this claim. Claims 2-13 depend from claim 1 and therefore include all of the elements recited therein. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of claims 1-13 under 35 U.S.C. § 103(a) as being unpatentable over *Lynch*.

Independent claims 14 and 26, although of different scope, recites similar elements to claim 1. Claims 15-25 and 27-37 depend from independent claims 14 and 26 respectively and therefore include all of the elements recited therein. Accordingly, no *prima facie* case of obviousness has been established with respect to claims 14-37 at least for the reasons discussed above. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the rejection of claims 14-37 under 35 U.S.C. § 103(a) as being unpatentable over *Lynch*.

Moreover, Applicant respectfully requests the Examiner to properly communication the grounds of rejection for dependent claims 2-13, 15-25, and 27-37. As set forth in M.P.E.P. § 706.02(j), “[i]t is important for an examiner to properly communication the basis for a rejection so that the issue can be identified early and the applicant can be given a fair opportunity to reply.” The Examiner’s rejections are not properly communicated, as there is no explanation of why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification to meet the elements of claims 2-13, 15-25, and 27-37. The Examiner’s rejections are also not properly communication because there is no identification of how the prior art allegedly teaches or suggests each and every element of claims 2-13, 15-25, and 27-37.

V. Conclusion

In view of the foregoing remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against

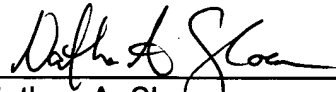
this application. Applicant therefore requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: July 25, 2005

By: 
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